

REMARKS

New claims 38 and 39 have been added by this amendment. New claim 38 finds support on page 4, line 15, of the specification. New claim 39 finds support on page 4, lines 22-24, of the specification.

The rejection of claims 16-18, 20-27, 30-32, and 36-37 under 35 U.S.C. 112, second paragraph, is obviated by appropriate amendment.

The term "a gene encoding an H₂O₂ producing protein" has been changed to "a gene sequence encoding an H₂O₂ producing protein" throughout the claims.

Claims 16 and 17, step (d), have also been amended to recite "containing only" instead of "only containing".

In view of the above amendments and remarks, Applicants respectfully submit that the amended claims are definite within the meaning of 35 U.S.C. 112, second paragraph. Withdrawal of this ground of rejection is therefore respectfully requested.

Claims 16-27, 30-32, and 36-37 were rejected under 35 U.S.C. 112, first paragraph, as containing subject matter not described in the specification in such a way as to enable one skilled in the art to which it pertains to make and/or use the invention.

Withdrawal of the rejection is urged.

In support of the arguments and reasoning set forth in their response filed on April 20, 2005, that the specification is clearly enabling for the scope of the claimed invention, Applicants submit herewith a Declaration under 37 CFR 1.132 by Dr. Alain Toppan, one of the inventors.

In his Declaration, Dr. Toppan states that the claimed method has been used as a routine method in his laboratory, notably for transforming rape, cauliflower, and tobacco. In

addition, Dr. Toppan states that as of Applicants' invention date, oilseed rape, cauliflower, chicory, sunflower, Jerusalem artichoke, tomato, sweet potato, radish, cucumber, tobacco, and numerous other plant species were known to give hairy root cultures after transformation by *Agrobacterium rhizogenes*, and that protocols for the selection and regeneration of these plants were available at the time of Applicants' invention, thus making it possible to carry out the method of the invention on many other plant species.

In his Declaration, Dr. Toppan also cites the publication entitled "Use of Ri-Mediated Transformation for Production of Transgenic Plants", by M. C. Christey, *In Vitro Cell. Dev. Biol. - Plant* 37:687-700 (2001), as evidence that prior to Applicants' invention date, numerous transgenic plants were obtained using *Agrobacterium rhizogenes* mediated transformation. According to Dr. Toppan, the Christey reference also indicates that there was no technical obstacle for obtaining transformed plants even for those species in which transformation was indicated as being carried out after Applicants' date of invention. A copy of the Christey reference is enclosed herewith and made of record herein.

Finally, Dr. Toppan states in his Declaration that any gene encoding an H₂O₂ producing protein can be used in the inventive method, and that there is no reason to doubt that the H₂O₂ producing proteins exemplified in the specification disclosure could be successfully used in the invention.

In view of the above, and Applicants' arguments and remarks already of record in this case, it is respectfully submitted that one of ordinary skill in the art would have been able to practice the claimed invention without an undue amount of experimentation. Accordingly, withdrawal of the rejection under 35 U.S.C. 112, first paragraph, is urged.

Applicants respectfully submit that the present invention is now in condition for

allowance. Early notification to that effect is earnestly solicited. If any final points remain that can be clarified by telephone, Examiner Helmer is encouraged to contact Applicants' attorney at the number indicated below.

Applicants hereby petition the Commissioner for Patents to extend the time for reply to the notice dated June 17, 2005, for three (3) months from September 17, 2005, to December 20, 2005. A duly completed credit card authorization form is attached to effect payment of the extension fee.

Respectfully submitted

A handwritten signature in black ink, appearing to read "Malcolm J. MacDonald", written in a cursive style.

Malcolm J. MacDonald
Reg. No. 40,250
Tel: (703) 837-9600 Ex. 24